

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-3 and 6-14 are pending; Claims 9 and 10 were previously withdrawn from consideration. Claim 1 is amended; and no claims are newly added or canceled herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 1-3, 6-8, and 11-14 were rejected under 35 U.S.C. § 103(a) as unpatentable over McGuire et al. (U.S. Pat. No. 6,254,965, hereafter McGuire) in view of the Akahori et al. (U.S. Pat. No. 5,310,587, hereafter Akahori) and Asahi (JP 4154573). For the reasons discussed below, this rejection is respectfully traversed.

Claim 1 relates to a kitchen sheet including a base sheet made of a fiber aggregate, the base sheet having a plurality of convex portions giving the kitchen sheet an apparent thickness of 1.0 mm or greater and a compressive recovery of 30% or more. As described in the specification, if the apparent thickness of the kitchen sheet is smaller than 1.0 mm, the passageways for water vapor formed of concavities connecting with each other are narrow, and the drops of condensation on the kitchen sheet come into direct contact with food.¹

McGuire describes a hydrophobic nonwoven web having a plurality of three dimensional protrusions. McGuire describes that the web may include a laminate. However, McGuire does not disclose or suggest that the laminate includes a combination of a melt-blown nonwoven fabric in a spun-bonded nonwoven fabric. McGuire also does not disclose or suggest a spun-bonded nonwoven fabric brought into contact with food. In addition, taking the teachings of McGuire as a whole, the dimension of the protrusions (i.e., height and cross-sectional area), one of ordinary skill in the art can determine that the three-dimensional sheet of McGuire does not possess the claimed range of compressive recovery.

¹ Specification, page 13, lines 10-15.

Akahori describes a wrapping for foods including a laminated composite sheet. The composite sheet includes a fluid impermeable sheet, an absorbent fiber sheet, and a hydrophobic fiber nonwoven fabric. The hydrophobic nonwoven fabric includes a melt-blown nonwoven fabric and touches food. By contrast, the melt-blown nonwoven fabric according to Claim 1 does not touch food. Further, the claimed sheet does not include (1) the absorbent fiber sheet and (2) the fluid impermeable sheet.

Asahi relates to food packaging material including a hydrophobic sheet, such as a melt-blown nonwoven fabric and a flash spun sheet. This sheet is used in a single ply and the use of a laminate is not disclosed or suggested by Asahi. Additionally, based on a reasonable interpretation of the teachings of Asahi, the hydrophobic sheet of Asahi does not include an uneven three-dimensional surface. Therefore, Asahi necessarily fails to disclose or suggest the claimed thickness and compressive recovery.

Moreover, as set forth in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Additionally, “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.”

In the outstanding Office Action, the motivation to combine McGuire, Akahori, and Asahi is not found within the teachings of any of the references. In fact, Applicants respectfully submit that it is only in light of teachings of the present specification that such a combination would become obvious.

“A patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious [something that is not admitted in this case] once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which

should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” In re Spinnoble, 405 F.2d 578, 585, 160 U.S.P.Q. 237, 243 (CCPA 1969).

In this case, although a kitchen sheet may be shaped or sized in numerous ways, Applicants discovered (as noted above) that if the apparent thickness is smaller than 1.0 mm, the passageways formed by convex portions are too small to effectively vent water vapor generated from food being heated. As a result, undesirable condensation forms on the kitchen sheet during heating. Furthermore, because the sheet has a specific compressive recovery (i.e., a compressive recovery of 30% or more, as recited in Claim 1) the convex portions are less likely to collapse due to food weight, securing the passageways between the convex portions.

Additionally, as is evident from the Applicants’ disclosure, to assert that the proposed modification of McGuire would only involve a mere change in the size motivated by the desire to increase absorbent capabilities and protection disregards the “as a whole” requirement set forth in MPEP § 2141.02. Accordingly, it is respectfully submitted that the applied combination of McGuire, Akahori, and Asahi is based upon hindsight reconstruction, and is impermissible. It is therefore respectfully requested that this rejection be withdrawn.

In the Advisory Action dated January 7, 2004, the Examiner indicated that the compressive recovery was inherent in the cited combination. However, as set forth in MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (emphasis in original) In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Additionally, to establish inherency, the extrinsic evidence must make clear that the missing matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of

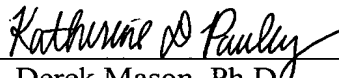
circumstances is not sufficient to prove inherency. MPEP § 2112, In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999). When relying upon the theory of inherency, the Examiner **must** provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied references. MPEP § 2112, Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicants respectfully submit that the Examiner has not satisfied the burden to prove inherency, as set forth in MPEP § 2112. Accordingly, it is respectfully requested that the outstanding rejection of Claims 1-3, 6-8, and 11-14 be withdrawn.

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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